

REMARKS

Applicant hereby adds new claims 27-32. Accordingly, claims 1-32 are pending in the present application.

Claims 22, 24, and 26 are objected to. Claims 21-26 stand rejected under 35 USC 112, first paragraph. Claims 1-26 stand rejected under 35 USC 103(a) for obviousness over U.S. Patent No. 6,108,099 to Ohtani in view of U.S. Patent No. 6,128,626 to Beauchense.

Applicant respectfully traverses the rejections and urges allowance of the present application.

Referring to the objection to the claims, Applicants have amended claims 22, 24, and 26 to correct the typographical errors.

Referring to the 112, first paragraph rejections of claims 21, 23, 25, the terms "initial" and "another" were used for clarity for reference to a plurality of entities (e.g., plural host devices 14 shown and described in one embodiment with respect to Fig. 2 of the originally-filed application). Applicants have amended the claims 21, 23, 25 to refer to "first" and "second" entities in an effort to further the prosecution of the present application. These claims are described and supported in one embodiment with respect to Fig. 2 in the specification of the application. Applicants respectfully request withdrawal of the rejections.

Referring to the 112, first paragraph rejections of claims 22, 24, 26, Applicants refer the Examiner to one exemplary embodiment of the specification at page 11, lines 20+ wherein it is stated that the first and second designations may correspond to manufacturer and customer part numbers for the same consumable. It is understood by one of skill in the art that plural part numbering systems use different part numbers and conversion is provided as disclosed to associate the different part numbers. One of skill in the art understands from the example of the specification that a manufacturer part number is not recognizable in a customer part numbering system in one example. Applicants respectfully submit the examples of the originally filed specification describe and support the limitations of the claims and Applicants respectfully request withdrawal of the rejections for at least this reason.

The amendments made herein with respect to the above now more positively express limitations which were previously inherent in such claim(s), and accordingly

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are not for the purpose of narrowing and do not effectively narrow the scope of any claim.

It is to be understood that any described arrangements, methodologies and associated remarks with respect to the 112 rejections are only for purposes of illustrating that the above-identified terms are adequately described and supported by the specification to one of skill in the art and are not to be considered limiting to the respective claims. Other additional arrangements and methodologies are possible and encompassed by the claims.

Referring to the obviousness rejection of claim 1, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8th ed., rev. 2). Applicants respectfully submit there is no motivation to combine the reference teachings and the rejection of claim 1 is improper for at least this reason.

More specifically, the Office states on page 4 of the Office Action that the combination is appropriate because operators may easily match a customer's part number with a manufacturer's part number by using the database of Beauchesne without having to contact the manufacturer for the part number and reduces time consumption and cost and improves the operability of the printing system by detecting and replacing new parts as detected by the printer's sensors. Applicants respectfully submit the alleged motivation is insufficient and Office has failed to meet their burden of establishing a proper *prima facie* 103 rejection for at least this reason.

Initially, the Federal Circuit discussed proper motivation *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). The motivation identified in the Office Action is akin to the conclusory statements set forth in *In re Lee* which were found to fail to provide the requisite motivation to support an obviousness rejection. The Court in *In re Lee* stated the factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. The Court in *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) stated motivation is provided only

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by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. The *Lee* Court stated that the Examiner's conclusory statements in the *Lee* case do not adequately address the issue of motivation to combine. The Court additionally stated that the factual question of motivation is material to patentability and can not be resolved on subjective belief and unknown authority. The Court also stated that deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense. The Court further stated that the determination of patentability must be based on evidence.

Applicants respectfully submit the Office has failed to present adequate *objective evidence of record* to support a proper prima facie 103 rejection. For example, there is *no evidence of record* that Ohtani is concerned with or experiences problems with respect to operators/users/clients ordering consumables. There is no evidence of record that users of Ohtani have to contact the manufacturer for part numbers or that there are any problems with respect to time consumption or costs as alleged by the Office to justify the combination. There is no evidence of record that the system of Ohtani uses different part numbers for identifying the same consumable which would lead to problems of identification of consumables to motivate one to look for solutions including conversion of part numbers in the first instance. The alleged motivation is faulty for at least this reason.

There is no evidence of record that one of skill in the art of consumable management of a facsimile system of Ohtani would look to Beauchesne concerned with solving problems with respect to *manufacturing assembly processes of PC circuit boards* wherein disparate part numbering systems are used for meaningful teachings. To the contrary, Ohtani provides an explicit detailed disclosure of consumable management which addresses problems in which Ohtani is concerned, namely the ordering of excessive consumables as provided at col. 1, lines 58-63 of Ohtani. Accordingly, to address this problem, Ohtani provides a comprehensive system in which human intervention provided in the form of an *official* may check inventory and place an order. There is absolutely no evidence of record that the official is burdened with excessive time consumption or excessive cost during the

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reordering process but to the contrary Ohtani *explicitly provides user intervention of the official to make sure excessive consumables are not ordered*. There is no evidence of record that a user of Ohtani has to contact a manufacturer to get a part number or that such would result in excessive time consumption or cost to motivate one to make the proposed combination of reference teachings.

Further, claim 1 explicitly claims the processing circuitry being configured to convert the first designation. On the other hand, Ohtani is *explicitly directed towards human intervention of the official to place an order for a consumable to avoid excessive consumable inventory*. Accordingly, there is no motivation to provide processing circuitry configured to convert an identifier to allegedly avoid cost or time consumption in view of the teachings of Ohtani to explicitly provide user interaction to avoid problems of concern in Ohtani of automatically ordering consumables without user intervention. The explicit provision of user interaction in Ohtani teaches away from the proposed combination of further automating the reordering process to allegedly reduce cost and time consumption. Ohtani is concerned with overstocking consumables and providing human intervention as opposed to the alleged motivation cited by the Office. The teaching away is the antithesis of the art's suggesting that the person of ordinary skill go in the claimed direction. Essentially, teaching away from the art is a *per se* demonstration of lack of obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988). Ohtani is explicitly directed towards a system which uses an official to place an order and the modification proposed by the office would frustrate this intervention of the official into the ordering process.

Preferably, the Examiner's explanation should be such that it provides that impetus necessary to cause one skilled in the art to combine the teachings of the references to make the proposed modification. *Ex Parte Levengood*, 28 USPQ2d, 1300, 1301, Footnote 2, (Bd. Pat. App. and Inter. 1993) (citations omitted)). The Office has failed to identify any problems of the system of Ohtani which would be cured or improved by the combination of reference teachings. There is insufficient motivation to combine the prior art teachings and claim 1 is allowable for at least this reason.

In addition, even if combined, the combination of reference teachings fails to disclose or suggest the claimed processing circuitry of the image forming device

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performing the conversion. The teachings of Fig. 5d are relied upon by the Office on page 4 of the Action as allegedly disclosing the claimed conversion. To the contrary, Fig. 5d merely discloses a prior art database organization and the Office has failed to identify any evidence that processing circuitry of Beauchesne provides any processing circuitry configured to perform the claimed conversion. *The mere listing of the plural part numbers in a database entry fails to disclose or suggest any conversion by processing circuitry* as positively claimed. Further, modifying or providing processing circuitry of Ohtani to implement conversion is contrary to the human intervention teachings of Ohtani.

Accordingly, even if the reference teachings are combined, the combination fails to disclose or suggest positively-recited limitations of claim 1 including the processing circuitry converting the first designation to a second designation and the Office has failed to establish a proper prima facie rejection for at least this additional reason.

In sum, there is no evidence of record that the system of Ohtani experiences problems without the conversion of part numbers or that the system would benefit from conversion to motivate one to look to Beauchesne for meaningful teachings. There is no appropriate impetus for one of skill in the art concerned with consumable management of a facsimile device of Ohtani to look to the disparate teachings of Beauchesne overcoming of problems of eliminating duplicate information in a database and providing historical information in the database *with respect to PC board assembly*. In fact, the teachings of Ohtani teach away from modifying Ohtani as alleged by the Office. In addition, even if the teachings of the references are combined, positively recited limitations of claim 1 are not disclosed nor suggested by the combination. Applicants respectfully request the Office has failed to establish a proper prima facie rejection of claim 1 and Applicants respectfully request allowance of claim 1 in the next Action for at least the above-mentioned compelling reasons.

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

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For example, referring to claim 2, the Office relies upon the teachings of paper supply and toner supply of Figs. 6-8 of Ohtani as allegedly disclosing the claimed second message comprising *a list including a plurality of second designations of a plurality of imaging consumables*. To the contrary, Ohtani explicitly discloses the usage of different emails of Figs. 6-8 depending upon the needs of the facsimile device and Applicants have failed to find any teachings regarding a list including a plurality of designations of a plurality of consumables as claimed. Also, Figs. 3-6 of Beauchesne refer to database entries of parts and Applicants have failed to uncover any teachings of a message comprising a list of plural designations for plural consumables as claimed. Positively recited limitations of claim 2 are not disclosed by the prior art and claim 2 is allowable for this additional reason.

Referring to claim 5, Applicants have failed to uncover any usage of customer and manufacturer part numbers in the system of Ohtani to motivate one of skill in the art to look to teachings regarding conversion between customer and manufacturer part numbers. Applicants have electronically searched Ohtani and have failed to uncover any teachings regarding "customer" or "manufacturer". There is no need to complicate or modify the teachings of Ohtani to address problems which are of no concern to Ohtani in the first instance. Limitations of claim 5 are not disclosed nor suggested by the art and claim 5 is allowable for at least this reason.

Referring to claim 8, the Office states that a purchase order can be sent to manufacturer at any time and depends upon user's preferences without the citation of any prior art teachings in support of the rejection. The Office has failed to recite any evidence of record to support the conclusory subjective opinions in the Office Action. Ohtani explicitly discloses the official placing a consumable order when appropriate at his choosing not at predetermined moments in time as claimed. Further, Ohtani teaches away from automation to send messages at predetermined moments in time by providing the explicit human interaction of the user. The limitations of claim 8 are not disclosed nor suggested by the art and claim 8 is allowable for at least this reason.

Applicants have identified herein limitations of claim 8 which are not disclosed nor suggested by the teachings of the prior art identified by the Office. In

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the event that a rejection of the claims is maintained with respect to the prior art, or a new rejection made, Applicants respectfully request identification *in a non-final action* of elements which allegedly correspond to limitations of the claims in accordance with 37 C.F.R. §1.104(c)(2). In particular, 37 C.F.R. §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified*. Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. *When a reference is complex or shows or describes inventions other than that claimed by Applicants, the particular teachings relied upon must be designated as nearly as practicable*. Applicants respectfully request clarification of the rejections with respect to specific references and specific reference teachings therein pursuant to 37 C.F.R. §1.104(c)(2) in a *non-final Action* if claim 8 is not found to be allowable.

Referring to claim 21, Ohtani is void of plural designations of a consumable which are used by different entities. The identifier of the consumable is provided to the official in the communication of Fig. 6 of Ohtani and the official may forward an order for the consumable when appropriate. There is no need or benefit from complicating Ohtani with the usage of different entities and designations usable by the plural entities and claim 21 is allowable for this additional reason.

Referring to claim 22, as set forth above, Ohtani is not concerned with customer or manufacturer part numbers as alleged by the Office and there is no benefit to complicate the system of Ohtani through modification to accommodate customer and manufacturer part numbers or other modification of designations of a consumable which are not recognizable by an entity. Claim 22 is allowable for this additional reason.

The claims which depend from independent claim 22 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to independent claim 9, Ohtani is void of disclosing or suggesting conversion of a designation identifying an imaging consumable. Ohtani explicitly discloses *human intervention* in an ordering process which does not utilize plural part numbering systems. The combination of prior art would not improve the systems or methods of Ohtani and there is no motivation to combine the prior art

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teachings. Further, Ohtani teaches away from the combination by using human intervention. There is no motivation to combine the prior art teachings and the Office has failed to establish a proper prima facie 103 rejection for at least this reason. Applicants request allowance of claim 9 in the next Action.

The claims which depend from independent claim 9 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to independent claim 14, Ohtani explicitly discloses *human intervention* in an ordering process which does not utilize plural part numbering systems. Ohtani does not disclose converting the first designation as claimed. The combination of prior art alleged by the Office would not improve the systems or methods of Ohtani and there is no motivation to combine the prior art teachings. There is no motivation to combine the prior art teachings, Ohtani teaches away from the proposed modification and the Office has failed to establish a proper prima facie 103 rejection for at least this reason. Applicants request allowance of claim 14 in the next Action.

Applicants hereby add new claims 27-32 which are supported at least by the teachings at page 14, lines 2+ of the specification and the method of Fig. 5 executed by processing circuitry 44 in one embodiment.

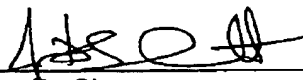
Applicant respectfully requests allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

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